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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,109	04/08/1999	KOICHI SATO	P17387	7068

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EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 09/21/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/288,109

Applicant(s)

SATO, KOICHI

Examiner

LUONG T NGUYEN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-24 is/are allowed.
- 6) ☒ Claim(s) 25-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/18/2004 has been entered.

Response to Arguments

2. Applicant's arguments with respect to newly added claims 25-33 filed on 8/18/2004 have been fully considered but they are not persuasive.

In re pages 7-8, Applicant argues that, in Nakamura, the depression of the switch comprises a single depression. On the other hand, the instant invention, as defined by the newly submitted claims, requires two different operations (e.g., types of actuation/depressions) for sequentially setting the photography mode and the reproduction mode, and such feature is submitted to be neither disclosed or suggested by Nakamura or the other art of the record.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *two different operations (e.g., types of actuation/depressions) for sequentially setting the photography mode and the reproduction mode*) are not recited in the rejected claim(s). Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In this case, regarding newly added claim 25, the Applicant recites the limitation “a printing operation start mechanism that activates said printing processor, said printing operation start mechanism being operated in accordance with **one of a first operation and a second operation** which is different from said first operation, so that said photography mode is set, and said reproduction mode is then automatically set.” It is noted that, the Applicant recites the alternative limitation “**one of**” in the limitation “**one of a first operation and a second operation**”. Therefore, the prior art can only read on “a first operation”. In this case, Nakamura discloses an operation (a first operation) of the first push-button switch 13 can take the image (photography mode) and print the image (reproduction mode is then automatically set, figure 1, column 3, lines 23-55).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 25-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (US 4,942,477).

Regarding claim 25, Nakamura discloses a printer (printer 12, figure 1) connectable to a still video camera (optical device 1, figure 1, column 3, lines 5-10), said printer comprising an

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image data receiving processor that receives said image data from said still video camera (inherently included in printer device 12, figure 1, column 3, lines 35-41); a printer processor that prints the image (column 3, lines 40-45); a printing operation start mechanism (first push button switch 13 and copy switch 17, figure 1, column 3, lines 24-56) that activates the printing processor, said printing operation start mechanism being operated in accordance with one of a first operation and a second operation which is different from said first operation, so that said photography mode is set, and said reproduction mode is then automatically set.” It is noted that, the Applicant recites the alternative limitation “one of” in the limitation “one of a first operation and a second operation”. Therefore, the prior art can only read on “a first operation”. In this case, Nakamura discloses an operation (a first operation) of the first push-button switch 13 can take the image (photography mode) and print the image (reproduction mode is then automatically set, figure 1, column 3, lines 23-55).

Regarding claim 26, Nakamura discloses wherein said printing operation start mechanism comprises a print start switch depressible to activate a printing operation of said printing processor (first push-button switch 13, figure 1, column 3, lines 23-55).

Regarding claim 27, Nakamura discloses wherein an image corresponding to image data obtained by said photography mode is printed by the printer (column 3, lines 45-50).

Regarding claim 28, Nakamura discloses wherein said first operation comprises a continuous operation over a predetermined period of one of said printing operation start

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mechanism (the first push-button switch 13 determines a timing at which a picture image is to be taken out, figure 1, column 3, lines 24-56).

Regarding claim 29, Nakamura discloses wherein said second operation comprises plural depressions of said printing operation start mechanism (push-button 13 and copy switch 17, figure 1, column 3, lines 24-56).

Regarding claim 30, Nakamura discloses a camera-printer system, comprising a still video camera that performs (camera 1, figure 1), in a photography mode, a photographing operation of an image, said still video camera being provided with a first switch (second push-button switch 28, figure 1, column 3, lines 24-28); a printer (printer device 12, figure 1, column 3, lines 35-55); a second switch (first push-button switch 13, figure 1, column 3, lines 45-55); an image data transmission processor (controller 10 and cable 11, figure 1, column 3, lines 35-42, column 4, lines 13-15); one of said first switch and said second switch being operated in accordance with one of a first operation and a second operation which is different from said first operation, so that said photography is set, and said reproduction mode is then automatically set, whereby said printer carries out a printing operation. It is noted that, the Applicant recites the alternative limitation "one of" in the limitation "one of said first switch and said second switch", and the alternative limitation "one of" in the limitation "one of a first operation and a second operation". Therefore, the prior art can only read on "a second switch" and "a first operation". In this case, Nakamura discloses an operation (a first operation) of the first push-button switch

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13 (a second switch) can take the image (photography mode) and print the image (reproduction mode is then automatically set, figure 1, column 3, lines 23-55).

Regarding claim 31, Nakamura discloses a release switch depressible to activate said photographing operation (second push-button switch 28, figure 1, column 3, lines 24-28).

Regarding claim 32, Nakamura discloses a print start switch depressible to activate said printing operation (first push-button switch 13, figure 1, column 3, lines 24-28).

Regarding claim 33, Nakamura discloses wherein said first operation comprises a continuous operation over a predetermined period of one of said first and second switches (the first push-button switch 13 determines a timing at which a picture image is to be taken out, figure 1, column 3, lines 24-56).

Regarding claim 34, Nakamura discloses wherein said second operation comprises a plural depressions of one of said first switch and said second switch (first push-button switch 13, figure 1, column 3, lines 24-56).

Allowable Subject Matter

5. Claims 20-24 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

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Regarding claim 20, the prior art of the record fails to show or fairly suggest a still video camera connectable to a printer, comprising an image data transmitting processor that transmits, in a reproduction mode, said image data to said printer, said image data generating mechanism being operated in accordance with one of a first operation and a second operation which is different from said first operation, so that said photography mode is set, and said reproduction mode is then automatically set, whereby said printer carries out a printing operation.

Claims 21-24 are allowable for the reason given respect to claim 20.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T NGUYEN whose telephone number is (703) 308-9297. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN LN
09/19/04


AUNG MOE
PRIMARY EXAMINER